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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,208	11/01/2000	Heikki Wikstedt	796.375USW1	4676

32294 7590 01/13/2004

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EXAMINER

TRINH, SONNY

ART UNIT PAPER NUMBER

2685

DATE MAILED: 01/13/2004

*16*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/704,208

Applicant(s)

WIKSTEDT ET AL.

Examiner

Sonny TRINH

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 8-10 is/are allowed.
- 6) ☒ Claim(s) 11-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because figure 8 contains foreign language (non English). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 11** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11 (page 5 line 3 of amendment received 10/22/03), the term "signaling at the base transceiver station" is incomplete. It is suggested that Applicant put the term "are measured" back in claim 11 to read:

"...signaling are measured at the base transceiver station..."

### ***Allowable Subject Matter***

3. The indicated allowability of **claims 20 and 21** are withdrawn in view of the newly discovered reference(s) to Hamalainen et al. (U.S. 6,148,209) and Weaver, Jr. et al. (U.S. 5,715,526) respectively. Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. **Claim 20** is rejected under 35 U.S.C. 102(a) as being anticipated by Hamalainen et al. ("Hamalainen"; U.S. Patent Number 6,148,209).

Regarding claim 20, Hamalainen discloses a Mobile communications system including base transceiver stations and mobile stations, characterized in that the mobile communications system is adapted to start a conditional handover and to supply a criterion for the conditional handover to the base transceiver station (figure 7, column 7 line 51 to column 8 line 19, the condition is the high speed data call), to measure the signal of the mobile station's handover signaling at the base transceiver station, to compare the measurement results with the pre-established criterion, and to interrupt the handover, when the mobile station signal as a result of the comparison does not meet the pre-established criterion (column 8 line 3-19).

5. **Claim 21** is rejected under 35 U.S.C. 102(a) as being anticipated by Weaver, Jr. et al. ("Weaver"; U.S. Patent Number 5,715,526).

Regarding **claim 21**, Weaver discloses base transceiver station (figure 7's, see descriptions in columns 15-16), including a handover-signaling unit for controlling the handover signaling (inherent), wherein in that the base transceiver station also includes

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measuring means for measuring the signal of the handover signaling received from the mobile station, and comparison means for comparing the measurement results of the measuring means with the pre-established criterion for continuation of handover, whereby as a result of the comparison a control signal is obtained for the handover-signaling unit (figure 7B, column 16 lines 27-38).

***Allowable Subject Matter***

6. **Claims 1-6, 8-10** are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding independent claim 1, the cited prior art fails to teach or suggest the claimed limitations with the reasons set forth in the Applicant's Remarks and amendment filed on 10/22/03, paper number 15, pages 9-16.

**Claims 11-16 and 18-19** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. Regarding independent claim 11, the cited prior art fails to teach or suggest the claimed limitations with the reasons set forth in the Applicant's Remarks and amendment filed on 10/22/03, paper number 15, pages 9-16.

***Conclusion***

***Any response to this action should be mailed to:***

*Commissioner of Patents and Trademarks*

*Washington, D.C. 20231*

***or faxed to:***

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*(703) 872-9314, (for formal communications intended for entry, for informal or draft communications, please label "PROPOSED" or "DRAFT")*

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, 6<sup>th</sup> Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny Trinh whose telephone number is (703) 305-1961. The examiner can normally be reached Monday through Thursdays from 7:00 am to 4:00 p.m., and on alternate Fridays.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

*Sonny Trinh*

Patent Examiner  
1/8/04

**SONNY TRINH**  
**PATENT EXAMINER**

*S.T.*